

# Office Action Summary

Application No.

09/439,655

Applicant(s)

MORRISON ET AL.

Examiner

Judy M. Reddick

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1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 November 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

**DETAILED ACTION**

**Information Disclosure Statement**

1. **The information disclosure statement filed 11/12/99 has been considered and placed in the application file.**

**Claim Rejections - 35 USC § 112**

2. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

3. **Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**A) The recited "ethylene vinyl acetate" per claims 1 and 8 constitute indefinite subject matter as per it not being readily ascertainable if monomers or a copolymer of ethylene-vinyl acetate is intended.**

**B) The recited contents governing components a), b) and c) per claims 1 and 8 constitute indefinite subject matter as per it not being readily ascertainable as to the exact entity that such is based on, i.e., total adhesive composition or else?**

**C) The recited "copolymer" per claims 4 and 5 constitute indefinite subject matter as per the non-express establishment of proper antecedent basis.**

**D) It is suggested that a hyphen be inserted between ethylene and vinyl acetate per claims 4 and 5 so as to engender claim language clarity and art acceptance.**

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- E) The recited "low melting point" per claim 6 constitutes indefinite subject matter as per the metes and bounds of the term "low" engender an indeterminacy in scope.**
- F) The recited "rosin derivatives" per claim 7 constitutes indefinite subject matter as per the metes and bounds of "derivatives" engender an indeterminacy in scope.**
- G) The recited "aromatically modified aliphatic hydrocarbons" per claim 7 constitutes indefinite subject matter as per the metes and bounds of said compounds engender an indeterminacy in scope.**
- H) The recited "modified terpene" per claims 3 and "modified terpenes" per claim 8 constitute indefinite subject matter as per the metes and bounds of the term "modified" engender an indeterminacy in scope.**
- I) The recited "hydrogenated glycerol, pentaerythritol" per claim 8 constitutes indefinite subject matter as per it not being readily ascertainable if such is intended to qualify the "glycerol" and the "pentaerythritol" or the "glycerol" only.**

#### **Specification**

- 4. The use of the trademarks "DERTOPHENE T 105", "PERMALYN", etc. have been noted in this application. See, e.g., page 3. It should be capitalized wherever it appears and be accompanied by the generic terminology.**

**Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.**

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### **Double Patenting**

5. **The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).**

**A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).**

**Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).**

6. **Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,117,945. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims overlap in scope with the claims of U.S. '945.**

### **Claim Rejections - 35 USC § 102**

7. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless -**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

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8. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

9. *Claims 1-9 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mehaffy et al (U.S. 6,117,945).*

*Mehaffy et al disclose and exemplify hot melt adhesive compositions, useful in the formation of a carton, case or tray, and defined basically as containing 5 to 45 wt.% of an ethylene-vinyl acetate copolymer governed by greater than 30 wt.% of vinyl acetate and having a MI of at least 700 dg/min, 10 to 60 wt.% of a thermoplastic hydrocarbon, 5 to 25 wt.% of a compatible adhesive promoting tackifier which include terpene, terpene phenolic and phenolic-modified terpene resins and governed by a Ring and Ball softening point of about 112 degrees C, 10 to 40 wt.% of a wax governed by a melting point of about 130 to 180 degrees F and optionally 5 to 25 wt.% of an ethylene-vinyl acetate copolymer governed by a vinyl acetate content of less than 30 wt. % and a melt index of at least 400 dg/min and other conventional additives which include stabilizers, antioxidants, etc. See, e.g., the Abstract, cols. 1-4, Runs I, II and III and the Claims of Mehaffy et al. Mehaffy et al therefore anticipate the*

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*instantly claimed invention with the understanding that the components of the adhesive of Mehaffy et al clearly overlap in scope with the claimed adhesive components, in both content and character.*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

10. *Claims 1-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kosaka et al(U.S.*

*3,944,695), Bodourogrou(U.S. 4,960,295) or Liedermooy et al(U.S. 5,500,472).*

*Kosaka et al teach and exemplify compositions define basically as containing 10-60 wt.% of at least one tackifier which includes terpene resins, styrene-olefin polymers, rosins, etc., 5 to 50 wt.% of at least one wax component which include synthetic waxes, etc., 10 to 60 wt.% of an ethylene-vinyl acetate copolymer governed by a content of vinyl acetate of 5- to 50 wt.% and a melt index of 4 to 1000g/10 min, 5 to 40 wt. % of a filler and a pigment. See, e.g. the Abstract, cols. 1-2 and the Runs, especially Run 7. Kosaka et al therefore anticipate the instantly claimed invention, in both content and character.*

*Bodourogrou discloses and exemplifies hot melt adhesive compositions containing a primer and a glue formulation wherein the primer formulation contains between about 10 and about 20 wt. % of a suitable high melting point microcrystalline wax, between about 25 to about 50 wt.% of a combination of tackifying resins which include terpene resins, rosins, etc., between about 35 to about 45 wt.% of suitable backbone*

*polymers which include ethylene-vinyl acetate polymers governed by a vinyl acetate content of between about 5 and 40 wt.% and a melt index of between 300 and 400 and other conventional additives which include stabilizers, pigments, etc. and wherein the glue formulation contains between about 15 to about 25 wt.% of a suitable high melting point microcrystalline wax, between about 20 to about 45 wt.% of at least one tackifying resin which includes terpene resins, rosins, etc., between about 40 to about 50 wt.% of backbone polymers which include ethylene-vinyl acetate polymers governed by a vinyl acetate content of between about 5 and 40 wt.% and a melt index of 300 to 400 and other conventional additives which include coloring agents, stabilizers, etc. See, e.g., the Abstract, the paragraph bridging cols. 4-5, cols. 5-7 and the Runs of Bodouroglou. Bodouroglou therefore anticipates the instantly claimed invention in both content and character.*

*Liedermooy et al teach and exemplify hot melt adhesive compositions, useful in forming a case, carton and tray, defined basically as containing 15-40 wt.% of ethylene n-butyl acrylate, 25-55 wt.% of a terpene phenolic tackifying resin or a hydrogenated derivative thereof having a Ring and Ball softening point of less than 125 degrees C, 15 to 40 wt.% of a synthetic Fischer-Tropsch wax having a melting point of 180 degrees F, up to about 20 wt.% of an ethylene-vinyl acetate polymer containing 10 to 40 wt.% of vinyl acetate and other conventional additives such as stabilizers. See, e.g., the Abstract, the paragraph bridging cols. 1-2, col. 2 and Runs 3 and 6 of Liedermooy et al.*

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***Liedermooy et al therefore anticipate the instantly claimed invention, in both content and character.***

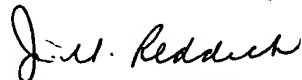
**Conclusion**

***11. The prior art to Brady et al(U.S. 4,816,306) and Albrecht(U.S. 5,928,782) made of record and not relied upon is considered of interest in exemplifying hot melt adhesives overlapping in scope with the claimed hot melt adhesives and considered merely cumulative to the prior art of record. The remainder of the prior art is cited as of being illustrative of the general state of the art.***

***Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..***

***If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.***

***Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.***

  
**Judy M. Reddick  
Primary Examiner  
Art Unit 1713**



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**JMR** *JMR*  
**August 17, 2001**